

~~Please amend Claim 18 as follows:~~

18. The process of Claim 8 wherein the coffee extract is diluted at a coffee extract to water ratio in the range of from about zero to about 1:15.

~~Please amend Claim 19 as follows:~~

19. The process of Claim 11 wherein the coffee extract is diluted at a coffee extract to water ratio in the range of from about zero to about 1:15.

## REMARKS

### Application Amendments

By the amendments presented herein, Claim 8-19 have been amended to more particularly point out and distinctly claim the subject matter that the Applicants regard as their invention.

Basis for these amendments presented herein can be found in claims 8-33 as originally filed, and in the Specification at Page 4, Line 29 – Page 5, Line 3; Page 5, Lines 34-35; Page 7, Line 34 – Page 8, Line 5; Page 8, Lines 10-12; and throughout the remainder of the Specification.

Attached hereto is a marked-up version of the changes made to the claims by current amendment. The attached page is captioned “VERSION WITH MARKINGS TO SHOW CHANGES MADE.”

Upon entry of the amendments presented, Claims 8-33 remain pending in the application. No additional claims fee is believed due as a result of these amendments.

### Statutory Type Double Patenting Rejection under 35 U.S.C. §101

The Examiner has provisionally rejected Claims 8-33 under 35 U.S.C. § 101 as claiming the same invention as that of Claims 1-26 of co-pending Application No. 09/638,567. Applicants expressly abandoned the above-identified co-pending application, ~~though not the invention contained therein~~, on 20 September, 2002, thereby obviating the rejection. Accordingly, Applicants respectfully assert that continued rejection of Claims 8-33 of the present Application on these grounds would be improper and should be withdrawn.

### Formal Matters

#### Rejection of Claims 8-33

Applicants' Claims 8-33 have been rejected under 35 U.S.C. § 112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter that Applicants regard as their invention. Applicants respectfully traverses this rejection.

The Examiner has rejected Claims 8-13 on the grounds the terms “a minimum period of about” and “a maximum period of about” are confusing because “it is not clear whether a range is being claimed or a specific time period.” (Paper No. 7, Page 2, Item No. 4). By the amendments presented the claims have been rewritten to more particularly point out and distinctly claim the subject matter that Applicants regard as their invention, thereby obviating this rejection.

As is well settled, all that is required to comply with 35 USC §112, second paragraph, is that the metes and bounds of what is claimed be determinable with a reasonable degree of precision and particularity. *Ex parte Wu*, 10 USPQ2d 2031, 2033 (BPAI 1989). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope when it is read in light of the specification. *In re Warmerdam*, 31 USPQ 2d 1754, 1759 (Fed. Cir. 1994). Applicants respectfully assert that the claims as amended meet that standard.

It is respectfully submitted that the scope of Claims 8-13 are readily ascertainable to one skilled in the art when the claims are read in light of the Description portion of the Specification and the state of the art as of the filing date of the present application. With respect to the amendments made herein, Applicants assert that the claims are clear to the ordinarily skilled artisan that what is being claimed is a period of time, either ending with or beginning with the stated time.

The Examiner has further rejected Claims 8-13 on the grounds that the terms “the onset of brewing” and “the coffee extract” lack antecedent basis, stating that “it is not clear whether the delay time is intended to begin once brewing begins or at some point after brewing begins.” (Paper No. 7, Pages 2-3, Item No. 4). Applicants have amended the claims to more distinctly point out and clearly identify the claimed invention, thereby obviating this rejection.

With respect to use of the term “coffee extract,” the claims have been amended such that the first occurrence of “coffee extract” is preceded by the appropriate article “a.” As this amendment now provides proper support for subsequent occurrences of the term in the claims Applicants respectfully assert that continued rejection of these claims on this ground would be improper and should be withdrawn.

With respect to use of the term “onset of brewing,” the claims have been amended to more particularly point out and distinctly claim the invention. Applicants respectfully assert that the terms “the onset” and “onset” are commonly known in the art and refer to an event in the brewing process. Applicants further assert that the terms “the onset of brewing” and

“onset of brewing,” as used in the present context, refer to the specific event of when water comes into contact with the roast and ground coffee resulting in the formation of a coffee extract. As the metes and bounds of what is claimed is readily determinable with a reasonable degree of precision and particularity to the ordinarily skilled artisan, as required under the law, Applicants assert that continued rejection of these claims on this ground would be improper and should be withdrawn.

The Examiner has rejected Claims 14-17 under 35 U.S.C. § 112, Second Paragraph stating that the term “the extract portion” lacks antecedent basis. (Paper No. 7, Page 3, Item No. 4). Applicants have amended the claims to more distinctly point out and clearly identify the claimed invention. Therefore, Applicants respectfully assert that continued rejection of these claims on this ground would be improper and should be withdrawn.

The Examiner has rejected Claims 18-19 under 35 U.S.C. § 112, Second Paragraph stating that the term “the coffee/water dilution ratios” lacks antecedent basis. *Id.* Applicants have amended the claims to more distinctly point out and clearly identify the claimed invention. Applicants have also corrected a minor typographical error in Claim 18. Therefore, Applicants respectfully assert that continued rejection of these claims on this ground would be improper and should be withdrawn.

The Examiner has rejected Claims 14-17 under 35 U.S.C. § 112, Second Paragraph stating that the claims are confusing because “they refer to roast and ground coffee, but this is not specified in other claims.” *Id.*

Applicants respectfully repeat that it is well settled, and all that is required to comply with 35 USC §112, second paragraph, is that the metes and bounds of what is claimed be determinable with a reasonable degree of precision and particularity. *Ex parte Wu*, 10 USPQ2d 2031, 2033 (BPAI 1989). It is respectfully submitted that the scope of Claims 14-17 are readily ascertainable to one skilled in the art when the claims are read in light of the ~~Description portion of the Specification and the state of the art as of the filing date of the~~ present application.

Therefore, as the legal standard for definiteness (i.e., whether a claim reasonably apprises those of skill in the art of its scope when it is read in light of the specification, *In re Warmerdam*, 31 USPQ 2d 1754, 1759 (Fed. Cir. 1994)), has been satisfied, Applicants respectfully assert that continued rejection of these claims on this ground would be improper and should be withdrawn.

Applicants have made an earnest effort to obviate the above detailed rejections and place their claims in condition for allowance. Therefore, Applicants respectfully suggest that continued rejection of Claims 8-33 under § 112, Second Paragraph would be improper and should be withdrawn.

#### **Art Rejections**

Claims 8-10 have been rejected under 35 U.S.C. §102(b) as anticipated by Panesar (EP 893065). Claims 11-19, 24-26, and 31-33 have been rejected under 35 U.S.C. §103(a) as unpatentably obvious over Panesar (EP 893065). Claims 8-33 have been rejected under 35 U.S.C. §103(a) as unpatentably obvious over Kalenian (U.S. Patent No. 6,203,837 B1). Applicants hereby traverse these rejections.

#### **Rejection under 35 USC §102(b)**

Claims 8-10 have been rejected under 35 U.S.C. §102(b) as anticipated by Panesar (EP 893065). The Examiner contends that Panesar discloses the “preparation of a concentrated coffee extract [that] is packaged and diluted at a later time, for example as late as 16 weeks.” (Paper No. 7, Page 3, Item No. 5). Applicants hereby traverse this rejection.

As is well settled, anticipation requires “identity of invention.” *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claim. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984). Furthermore, in a §102(b) rejection there must be no difference between what is claimed and what is disclosed in the applied reference. *In re Kalm*, 154 USPQ 10, 12 (CCPA 1967); *Scripps v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Applicants’ Claims 8-10 have been amended to more particularly point out and distinctly claim the subject matter that Applicants regard as their invention. Panesar specifically discloses a “high concentration aromatized liquid coffee extract having a soluble solids concentration greater than 55%, which is used in the making of liquid coffee products” (Page 3, Lines 30-31). In contrast, the present invention claims a coffee extract with a brew solids level in excess of about 1.2% and **less than** about 30%, preferably less than about 10%, more preferably below about 5%, yet more preferably below about 4%, and even more preferably below about 3.5% (See Specification at Page 4, Line 29 - Page 5, Lines 3 and at Page 5, Lines 34-35).

As the Panesar reference fails to disclose each and every element of Applicants’ claimed invention, Applicants respectfully assert that continued rejection of Claims 8-10 on this ground would be in error and should be withdrawn.

### Rejections under 35 USC §103(a)

Claims 11-19, 24-26, and 31-33 have been rejected under 35 U.S.C. §103(a) as unpatentably obvious over Panesar (EP 893065). Claims 8-33 have been rejected under 35 U.S.C. §103(a) as unpatentably obvious over Kalenian (U.S. Patent No. 6,203,837 B1). Applicants hereby traverse these rejections.

It is respectfully submitted that Applicants' Claims are patentable, as the Examiner has failed to establish a *prima facie* case of obviousness. According to Section 706.02(j) of the MPEP, the Examiner must meet three basic criteria to establish a *prima facie* case of obviousness:

- (1) First, there must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings.
- (2) Second, there must be a reasonable expectation of success in obtaining the claimed invention based upon the references relied upon by the Examiner.
- (3) Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP Section 706.02 (j) further requires that the teaching or suggestion to make the modification or reference combination, and the expectation of success, must be found in the prior art, and may not be based upon the applicant's disclosure.

### Rejection under 35 U.S.C. §103(a) in view of Panesar (EP 893065)

The Examiner contends that Claims 11-19, 24-26, and 31-33 are unpatentable under 35 U.S.C. §103(a) in view of Panesar (EP 893065). Applicants hereby traverse this rejection.

As detailed above, MPEP §706.02(j) specifically requires that in order for an Examiner to establish a *prima facie* case of obviousness the cited reference or references must teach or suggest all the claim limitations of the claimed invention. Here, the Examiner has failed to do so. The Panesar reference specifically discloses coffee extracts with soluble solids levels in excess of 55%. In contrast, Applicants' present invention claims a coffee extract with a brew solids level in excess of about 1.2% and less than about 30%.

As the cited reference fails to disclose each and every element of the present invention, Applicants respectfully assert that continued rejection of Claims 11-19, 24-26, and 31-33 on these grounds would be improper and should be withdrawn.

### Rejection under 35 U.S.C. §103(a) in view of Kalenian (U.S. Patent No. 6,203,837 B1)

The Examiner contends that Claims 8-33 are unpatentable under 35 U.S.C. §103(a) as over Kalenian (U.S. Patent No. 6,203,837 B1). Applicants hereby traverse this rejection.

As detailed above, MPEP §706.02(j) specifically requires that in order for an Examiner to establish a *prima facie* case of obviousness the cited reference or references must teach or suggest all the claim limitations of the claimed invention. Here, the Examiner has failed to do so.


As recognized by the Examiner the Kalenian reference differs for the present invention with regard to the amount of brew solids as well as the dilution ratios employed (Paper No. 7, Page 4, Item No. 7). In fact however, Kalenian fails to disclose or even suggest the use of Applicants' claimed brew solids range and/or dilution ratios. Moreover, Kalenian fails to disclose or even suggest other elements of Applicants' claimed invention including a range of suitable Delta Standard Yield and extract preparation ratio ranges for water and dry, roast and ground coffee.

As the cited reference fails to disclose each and every element of the present invention, Applicants respectfully assert that continued rejection of Claims 8-33 on these grounds would be improper and should be withdrawn.

#### Conclusion

Applicants have made an earnest effort to place their application in proper form and to distinguish their claimed invention from the applied art. WHEREFORE, reconsideration of this application, withdrawal of the provisional double patenting rejection under 35 U.S.C. §101, withdrawal of the rejections under 35 U.S.C. §112, Second Paragraph; 35 U.S.C. §102(b); and 35 U.S.C. §103(a), and allowance of Claims 8-33 are respectfully requested.

Respectfully submitted,  
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Claim 8 has been amended as follows:

8. A process for making a customized coffee beverage product by delaying [the] dilution of [the] a coffee extract for a [minimum] period of time in excess of about 5 minutes after [the] onset of brewing of the extract, wherein the coffee extract has a brew solids level of less than about 30% and a Delta Standard Yield of less than about 10%.

Claim 9 has been amended as follows:

9. A process according to Claim 8 for making a customized coffee beverage product by delaying [the] dilution of [the] a coffee extract for a [minimum] period of time in excess of about 15 minutes after the onset of brewing of the extract.

Claim 10 has been amended as follows:

10. A process according to Claim 9 for making a customized coffee beverage product by delaying [the] dilution of the coffee extract for a [minimum] period of time in excess of about 30 minutes after [the] onset of brewing of the extract.

Claim 11 has been amended as follows:

11. A process according to Claim 10 for making a customized coffee beverage product by delaying [the] dilution of [the] a coffee extract for a maximum period of about 48 hours after [the] onset of brewing of the extract.

Claim 12 has been amended as follows:

12. A process according to Claim 11 for making a customized coffee beverage product by delaying [the] dilution of [the] a coffee extract for a [maximum] period of time of less than about 24 hours after [the] onset of brewing of the extract.

Claim 13 has been amended as follows:

13. A process according to Claim 12 for making a customized coffee beverage product by delaying [the] dilution of [the] a coffee extract for a [maximum] period of time of less than about 12 hours after [the] onset of brewing of the extract.

Claim 14 has been amended as follows:

14. The process of Claim 8 wherein the coffee extract is prepared from ingredients comprising an extract portion of water and a dry, roast and ground coffee, and the

weight ratio of the extraction portion of water to the dry, roast and ground coffee is in the range of from about 5:1 to about 24:1.

Claim 15 has been amended as follows:

15. The process of Claim 14 wherein the weight ratios of the extraction portion of water to the dry, roast and ground coffee is in the range of from about 8:1 to about 13:1.

Claim 16 has been amended as follows:

16. The process of Claim 11 wherein the weight ratio of the extraction portion of water to the dry, roast and ground coffee is in the range of from about 5:1 to about 24:1.

Claim 17 has been amended as follows:

17. The process of Claim 11 wherein the weight ratios of the extraction portion of water to the dry, roast and ground coffee is in the range of from about 8:1 to about 13:1.

Claim 18 has been amended as follows:

18. The process of Claim 8 wherein the [coffee /water dilution ratios are] coffee extract is diluted at a coffee extract to water ratio in the range of from about zero to about 1:15.

Claim 19 has been amended as follows:

19. The process of Claim 11 wherein the [coffee /water dilution ratios are] coffee extract is diluted at a coffee extract to water ratio in the range of from about zero to about 1:15.